

**IN THE DRAWINGS**

Kindly replace Drawing Sheet 1/1 currently in the  
official USPTO file with the attached Replacement Sheet 1/1.

No new matter has been added.

### REMARKS

The application was filed with Claims 1-43. Claims 2-13 and 15-43 remain in the application. Claims 1-26 and 30-43 stand provisionally rejected on the grounds of non-statutory obvious-type double patenting as being unpatentable over Claims 1-33 of copending Application No. 10/630 378. Claims 1-43 stand rejected under 35 USC §112. Claims 1, 3-7, 13-14, 18-19, 26-28, 32-33, 38-41 and 43 stand rejected under 35 USC §102. Claims 2, 8-12, 15-17, 20-25, 29-31, 34-37 and 42 stand rejected under 35 USC §103. These rejections are respectfully traversed. Claims 1 and 14 having been cancelled, the rejections of Claims 1 and 14 should be considered moot, and withdrawal of the rejections is respectfully requested. In view of the foregoing, and the following remarks, withdrawal of the rejections of Claims 2-13 and 15-43, and reconsideration of the claims, is respectfully requested.

#### Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include reference characters not mentioned in the description. Specifically reference number 13, found in Figure 3, is not mentioned in the description. In the enclosed replacement sheet 1/1, Figure 3 has been revised to delete the reference number 13. No new matter has been added. Withdrawal of the objection is respectfully requested.

#### Specification

The abstract of the disclosure has been objected to because the abstract contains legal phraseology such as "comprises" and "comprising". The enclosed revised abstract of the disclosure has removed the objectionable phraseology. Withdrawal of the objection is respectfully requested.

#### Double Patenting Rejection

Claims 1-26 and 30-43 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 10/630,378. This rejection is respectfully traversed.

By the foregoing amendment, Claims 1 and 14 have been cancelled, and the remaining claims in the application have been amended to depend directly or indirectly from Claim 40, which has been rewritten in independent form. Claim 40 calls for a container having a wall comprising at least one layer. The claims of the copending application require that the container wall is formed having at least two layers. The claims of the copending application do not disclose the subject matter claimed in Claim 40, wherein the container wall may have only one layer. Further, it would not have been obvious, given the claims of the copending application, to form a container wall having a single layer. Withdrawal of the double patenting rejection of Claim 40 and its depending claims, and reconsideration of the claims, is respectfully requested.

Rejections Under 35 USC §112

Claims 1-43 stand rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This objection is respectfully traversed. By the foregoing amendment, the claims have been amended in accordance with all of the Examiner's recommendations, or cancelled. Therefore, withdrawal of the rejection, and reconsideration of the claims, is respectfully requested.

Rejections Under 35 USC §102

Claims 1, 3-7, 13-14, 18-19, 26-28, 32-33, 38-41 and 43 stand rejected under 35 USC §102(b) as being anticipated by US Patent 1 654 318 to Benson. These rejections are respectfully traversed.

It is well established that for a claim to be anticipated by a reference, each and every element of the claim must be found in that reference. Benson '318 discloses a paper drinking cup that is waterproofed, and particularly a paper drinking cup "of the type wherein the bottom closure is a separate piece sealed to the wall of the cup."

Claims 1 and 14 have been cancelled. Claims 3-7, 13, 18-19, 26-28, 32-33, 38-39, 41 and 43 have been amended to depend either directly or indirectly from amended claim 40.

Regarding the rejection of Claim 19, the Examiner has asserted that "the edges of the layer are fluid tight, since the container is used to contain liquids." This feature is not disclosed in Benson '318.

Regarding the rejection of Claim 26, Benson discloses a paper drinking cup formed from a first blank rolled to form the wall of the drinking cup, and a second blank secured to the first blank and forming the bottom of the paper drinking cup. Claim 26 requires that the closed end is formed by connecting lower end sections of the wall, and does not require a bottom insert. Benson '318 requires a bottom insert. Therefore Claim 26 is not anticipated by Benson '318.

Regarding the rejection of Claim 40, the Examiner has asserted that "the container [of Benson] is stable in the range of -50°C to +120°C, since the container is formed of paper stock for the purpose of forming a drinking cup." Benson '318 does not disclose any operating temperature range for the paper drinking cup. On the contrary, it is counterintuitive that a paper drinking cup would be constructed to withstand temperatures exceeding that of boiling water. Therefore, Claim 40 is not anticipated by Benson '318, and furthermore it would not have been obvious to modify Benson's paper drinking cup to withstand said elevated temperature range. Withdrawal of the rejection of Claim 40, and reconsideration of the claim, is respectfully requested. Further, withdrawal of the rejection of Claims 3-7, 13, 18-19, 26-28, 32-33, 38-39, 41 and 43, which depend either directly or indirectly from claim 40, and reconsideration of the claims, is also respectfully requested.

Rejections Under 35 USC §103

Claims 2, 8-12, 15-16, 23 and 25 stand rejected under 35 USC §103(a) as being unpatentable over Benson '318 in view of

US Patent 4 187 768 to Suzuki. This rejection is respectfully traversed.

In order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As discussed above with respect to the rejection of Claim 40 under 35 USC §102, Benson '318 does not disclose all of the limitations of Claim 40, and therefore Claim 40 is not anticipated by Benson '318. Suzuki '768 does not teach the elements missing from Benson '318 with respect to Claim 40. As a result, the combination of Benson '318 and Suzuki '768, even if made, fails to reach all of the limitations of Claim 40, and therefore also fails to reach the limitations of its depending claims. Withdrawal of the rejection of Claims 2, 8-12, 15-16, 23 and 25, and reconsideration of the claims, is respectfully requested.

Claims 17, 20-22, 24 and 34-36 stand rejected under 35 USC §103(a) as being unpatentable over Benson '318 in view of Suzuki '768 and further in view of US Patent 6 210 766 to McLaughlin. This rejection is respectfully traversed.

As discussed above with respect to the rejection of Claim 40 under 35 USC §102, Benson '318 does not disclose all of the limitations of Claim 40, and therefore Claim 40 is not anticipated by Benson '318. Neither Suzuki '768 nor McLaughlin '766 teaches the elements missing from Benson '318 with respect to Claim 40. As a result, the combination of

Benson '318 and Suzuki '768, even if made, fails to reach all of the limitations of Claim 40, and therefore also fails to reach the limitations of its depending claims. Withdrawal of the rejection of Claims 17, 20-22, 24 and 34-36, and reconsideration of the claims, is respectfully requested.

Further, regarding the rejection of Claim 36, McLaughlin does not disclose that the tube wall is transparent, and that therefore the printing would form a control window. Therefore, the combination of Benson, Suzuki and McLaughlin further does not reach the limitations of Claim 36, and withdrawal of the rejection and reconsideration of the claim is respectfully requested.

Claim 29 stands rejected under 35 USC §103(a) as being unpatentable over Benson '319 in view of US Patent 2 170 060 to Meyer. This rejection is respectfully traversed. Claim 29 calls for the material of the container to be transparent and colored. Meyer discloses forming a bead in the transparent material of a container and then inserting an ornamental cord or rope into the bead to be observed through the material. Neither Benson nor Meyer disclose coloring of the material, so that even if the combination were made, it does not reach the limitations of the claim.

Further, as discussed above with respect to the rejection of Claim 40 under 35 USC §102, Benson '318 does not disclose all of the limitations of Claim 40, and therefore Claim 40 is not anticipated by Benson '318. Meyer '060 does not teach the elements missing from Benson '318 with respect to Claim 40. As a result, the combination of Benson '318 and Meyer '060, even if made, fails to reach all of the limitations of Claim 40 and its depending claims. Withdrawal of the rejection of Claim 29, and reconsideration of the claim, is respectfully requested.

Claim 30 stands rejected under 35 USC §103(a) as being unpatentable over Benson '318 in view of US Patent 2 226 340 to Flood. This rejection is respectfully traversed.

As discussed above with respect to the rejection of Claim 40 under 35 USC §102, Benson '318 does not disclose all of the limitations of Claim 40, and therefore Claim 40 is not anticipated by Benson '318. Flood '340 does not teach the elements missing from Benson '318 with respect to Claim 40. As a result, the combination of Benson '318 and Flood '060, even if made, fails to reach all of the limitations of Claim 40 and its depending claims. Withdrawal of the rejection of Claim 30, and reconsideration of the claim, is respectfully requested.

Claim 31 stands rejected under 35 USC §103(a) as being unpatentable over Benson '318 in view of Suzuki '768 and further in view of Flood '340. This rejection is respectfully traversed.

As discussed above with respect to the rejection of Claim 40 under 35 USC §102, Benson '318 does not disclose all of the limitations of Claim 40, and therefore Claim 40 is not anticipated by Benson '318. Suzuki '768 and Flood '340 do not teach the elements missing from Benson '318 with respect to Claim 40. As a result, the combination of Benson '318, Suzuki '768 and Flood '340, even if made, fails to reach all of the limitations of Claim 40 and its depending claims. Withdrawal of the rejection of Claim 31, and reconsideration of the claim, is respectfully requested.

Claim 37 stands rejected under 35 USC §103(a) as being unpatentable over Benson '318 in view of US Patent 2 689 424 to Clagett. This rejection is respectfully traversed.

As discussed above with respect to the rejection of Claim 40 under 35 USC §102, Benson '318 does not disclose all of the limitations of Claim 40, and therefore Claim 40 is not anticipated by Benson '318. Clagett '424 does not teach the elements missing from Benson '318 with respect to Claim 40. As a result, the combination of Benson '318 and Clagett '424, even if made, fails to reach all of the limitations of Claim 40 and its depending claims. Withdrawal of the rejection of

Claim 37, and reconsideration of the claim, is respectfully requested.

Claim 42 stands rejected under 35 USC §103(a) as being unpatentable over Benson '318 in view of US Patent 4 574 987 to Halligan et al. This rejection is respectfully traversed.

As discussed above with respect to the rejection of Claim 40 under 35 USC §102, Benson '318 does not disclose all of the limitations of Claim 40, and therefore Claim 40 is not anticipated by Benson '318. Halligan et al. '987 does not teach the elements missing from Benson '318 with respect to Claim 40. As a result, the combination of Benson '318 and Halligan et al. '987, even if made, fails to reach all of the limitations of Claim 40 and its depending claims. Withdrawal of the rejection of Claim 42, and reconsideration of the claim, is respectfully requested.

Conclusion

In light of the foregoing, the objections to the specification and drawings having been addressed, and the claims being considered in condition for allowance, early Notice of Allowability is courteously solicited. If necessary to expedite further prosecution of the application, the Examiner is invited to contact the Applicant's representatives listed below.

Respectfully submitted,



A handwritten signature in black ink, appearing to read 'David G. Boutell', is written over a horizontal line.

David G. Boutell

DGB/DJW/jas



FLYNN, THIEL, BOUTELL	Dale H. Thiel	Reg. No. 24 323
& TANIS, P.C.	David G. Boutell	Reg. No. 25 072
2026 Rambling Road	Terryence F. Chapman	Reg. No. 32 549
Kalamazoo, MI 49008-1631	Mark L. Maki	Reg. No. 36 589
Phone: (269) 381-1156	Liane L. Churney	Reg. No. 40 694
Fax: (269) 381-5465	Brian R. Tumm	Reg. No. 36 328
	Steven R. Thiel	Reg. No. 53 685
	Donald J. Wallace	Reg. No. 43 977
	Kevin L. Pontius	Reg. No. 37 512
	Sidney B. Williams, Jr.	Reg. No. 24 949

Encl: Replacement Abstract  
Replacement Drawing Sheet 1/1  
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